

REMARKS

Claims 5 and 8 are pending in the present application. Claim 5 is herein amended.
Claims 6 and 7 are cancelled without prejudice.

Applicants' Response to the Rejection under 35 U.S.C. § 102 and § 103

Claims 5-8 were rejected under 35 U.S.C. § 102(e), as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Kojima (USP 6,253,866). The Office Action asserts that Kojima discloses a catalyst warming control apparatus containing a power distributing mechanism. The Examiner asserts that this power distributing mechanism functions to distribute or transmit a rotary force from at least one of the shafts of the engine and the electric motor to the generator, and that such a mechanism routinely utilizes clutches for starting the vehicle from a stopped position. Thus, the Examiner deemed a clutch to be inherent in the power distributing mechanism. Applicant respectfully traverses.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flow from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). A power distributing mechanism which is constructed of a planetary gear does not necessarily comprise a clutch for performing the connection or disconnection of the transmission of the power between the generator connected to the engine and the motor.

Kojima discloses a power distribution mechanism which is a planetary gear. This mechanism has the function of transmitting a rotary force from at least one of the shafts of the engine and the electric motor to the generator. The planetary gear of Kojima may be used as a

differential gear, and may be used as a transmission which cannot disconnect the engine from the motor. Thus, although a power distribution mechanism comprised of a planetary gear may contain a clutch, it does not necessarily contain one. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants respectfully submit that a clutch is not inherent in the power distributing mechanism of Kojima, and thus that Kojima does not anticipate claim 5 under 35 U.S.C. § 102(e).

Applicants further submit that the inclusion of a clutch in the catalyst warming control apparatus is not obvious in light of the prior art. Kojima discloses a power distributing mechanism which is a planetary gear. The planetary gear may be used as a differential gear, and is operated as a transmission which cannot disconnect the engine from the motor. As a result, in Kojima, the engine and the motor affect each other. See column 7, lines 52-59.

On the other hand, claim 5 recites a clutch for performing the connection or disconnection of the transmission of the power between the generator connected to the engine, and the motor. There is no suggestion or motivation in Kojima as to include a clutch. The use of this clutch permits the vehicle to be driven while changing power sources (a combustion engine or a motor) by means of a clutch to warm up the engine. Thus, Applicants respectfully submit that the use of a clutch is not obvious in view of Kojima and request favorable reconsideration of the §103 rejection.

Claim 5 has also been amended to specify a temperature detector. Support for this amendment may be found on page 13, lines 7-17 of the original specification.

Response under 37 C.F.R. §1.111
Attorney Docket No. 001062
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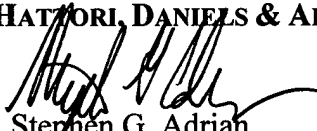
For at least the foregoing reasons, the claimed invention distinguishes over the cited art.
Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone Applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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